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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,388	03/17/2005	Helmut Schmidhammer	1739-10PUS	2841

27799	7590	12/05/2007
COHEN, PONTANI, LIEBERMAN & PAVANE		
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SUITE 1210		
NEW YORK, NY 10176		

EXAMINER	
AULAKH, CHARANJIT	

ART UNIT	PAPER NUMBER
1625	

MAIL DATE	DELIVERY MODE
12/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/519,388

Applicant(s)

SCHMIDHAMMER ET AL.

Examiner

Charanjit S. Aulakh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8 and 10-15 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/11/07.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. According to paper filed on Oct. 11, 2007, the applicants have filed a RCE.
2. Claims 1-6 and 8-15 are pending in the application.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 5, 6, 8 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Krassnig (Thesis for the degree of Ph.D in natural sciences, cited on applicant's form 1449).

Krassnig discloses Synthesis of 14-alkoxymorphinan-6-ones as potential sigma-opioid receptor antagonists. The compounds 39-41 (see page 57) as well as compound 19 (see page 59) disclosed by Krassnig anticipate the instant claims when R2 represents C7-C16-aryl alkyl or C8-C16-aryl alkenyl and R4 represents –OH or –OCH3 group in the instant compounds of formula (I).

4. Claims 1, 5, 6, 8, 10-12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Buckett (J. Pharm. Pharmacol.).

Buckett discloses esters of 14-hydroxycodeinone having analgesic activity. The two compounds disclosed in table 2 on page 70T (where R represents –COCH=CH.Ph or –COCH=CH.CH3) anticipate the instant claims when R2 represents either C3-C6-alkenoyl or C9-C16-arylalkenoyl in the instant compounds of formula (I).

5. Claims 2, 4-6, 8, 10 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Heinisch (Monatsh. Chem.).

Heinisch discloses Methanolysis of 14-bromocodeinone dimethyl acetal. The compound 6c (see page 531) disclosed by heinisch anticipates the instant claims when both R1 and R2 represent alkyl group and R4 represents -OCH3 group in the instant compounds of formula (IA).

6. Claims 1, 3, 5, 6, 8 and 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmidhammer (U. S. Patent 6,136,817).

Schmidhammer discloses Opioid receptor antagonists. The compounds of formulae (IV), (V), (VIII), (IX) and (X) disclosed (see column 5, line 50 to column 8, line 24) by Schmidhammer anticipate the instant claims when R2 represents C7-C16 arylalkyl, C8-C16-arylalkenyl or C9-C16-arylalkenoyl in the instant compounds of formula (I).

Allowable Subject Matter

7. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charanjit S. Aulakh whose telephone number is (571)272-0678. The examiner can normally be reached on Monday through Friday, 8:30 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on (571)272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/519,388
Art Unit: 1625

Page 4

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Charanjit S. Aulakh
Primary Examiner
Art Unit 1625